

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN PROVOST

Appeal No. 1998-0889
Application 08/006,585¹

ON BRIEF

Before THOMAS, BARRETT, and HECKER, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed January 21, 1993, entitled "Plastic Card Personalizer System."

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This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-23 and 41-47. Claims 24-40 stand allowed.

We affirm-in-part.

BACKGROUND

The disclosed invention is directed to a method and system for printing personal information on a prepared writing surface of a pre-manufactured plastic card at the time of issuance.

Claim 1 is reproduced below.

1. A system for electronically recording client personal information and issuing individually customized pre-manufactured plastic cards in a single interview with the card issuing authority, wherein the customized pre-manufactured plastic cards have a unique card identification affixed to each card and wherein a permanent record is made of the recorded client personal information by printing on a prepared writing surface on the customized pre-manufactured plastic card at the time of card issuance, comprising:

data entry means for entering the unique card identification and for entering client personal information which corresponds to the unique card identification during a client interview with the card issuing authority;

means for automatically creating an electronic client record of the unique card identification and corresponding client personal information at the time of card issuance;

means for storing the electronic client record at time of card issuance; and

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means for printing a permanent record of the client
personal information at time of card issuance, comprising:

plotting mechanism;

communication means for communicating client
personal information to the plotting mechanism;

a means for holding the customized
pre-manufactured plastic card in printing position;

smudge resistant ink; and

a means for delivering the ink such that the
ink instantly and permanently adheres to the prepared
writing surface.

The Examiner relies on Appellant's admitted prior art (APA)
(specification, p. 1) that cards were made of polyvinyl chloride
(PVC) or polyester and on the following prior art references:

Hyde	4,573,711	March 4, 1986
Cannistra	4,938,830	July 3, 1990
Markoff et al. (Markoff)	5,058,039	October 15, 1991

Hakamatsuka et al. (Hakamatsuka) 0 440 814 August 14, 1991
(European Patent Application)

Otsuka² 4-348996 December 3, 1992
(Japanese Published Unexamined Patent Application (Kokai))

Claims 1, 3, 4, 6-9, 17, 22, 23, and 41-46 stand rejected under
35 U.S.C. § 103(a) as being unpatentable over Hakamatsuka and Otsuka.

² Our understanding of Otsuka is based on a translation
prepared by the U.S. Patent and Trademark Office, a copy of which
accompanies this decision.

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Claims 2, 5, and 10-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakamatsuka and Otsuka, further in view of the APA.

Claims 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakamatsuka and Otsuka, further in view of Cannistra.

Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakamatsuka and Otsuka, further in view of Hyde.

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakamatsuka and Otsuka, further in view of Markoff.³

We refer to the Final Rejection (Paper No. 12), the Examiner's Answer⁴ (Paper No. 22) (pages unnumbered, but referred to as "EA__"), and the Supplemental Examiner's Answer (Paper No. 21) for a statement of the Examiner's position and to the Brief (Paper No. 21) (pages referred to as "Br__") and the Reply Brief (Paper No. 20) for Appellant's arguments thereagainst.

³ The Examiner's Answer includes claims 24-40 in this ground of rejection. However, claims 24-40 were indicated to be allowable in the Advisory Action (Paper No. 14).

⁴ For some unknown reason, the Examiner's Answer contains the following header: "Revision notes for the MPEFP Third Edition, Revision 1 [12/96]."

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OPINION

References not in the statement of rejection are not considered

In the response to the arguments in the Final Rejection, the Examiner cites the following references as evidence of the facts

Officially Noticed:

Oka et al.	3,897,964	August 5, 1975
Henderson	4,398,202	August 9, 1983
Mitsuyama	5,080,223	January 14, 1992
Hindagolla et al.	5,108,503	April 28, 1992
Venambre et al.	5,283,423	February 1, 1994
Sneed	5,521,002	May 28, 1996

Toda (Japanese abstract) 05-318985	March 4, 1994
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The Examiner also refers to Yoshikawa, but we find no record of the patent number in the file.

Since the references are not applied in the statement of the rejection they will not be considered. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection."). Introducing references through the "backdoor" to avoid creating a new ground of rejection or to bolster a rejection that is deficient is improper. Where references are cited in response to an

applicant's challenge to a finding of Official Notice, the references should be made part of the official rejection. The rejection we review is the one in the statement of the rejection.

Obviousness

Hakamatsuka discloses a system for issuing ID cards in which image data (e.g., a person's photograph, signature, etc.) and attribute data (e.g. name, employee number, address, telephone number, etc., col. 6, lines 26-28) are printed onto a pre-manufactured blank card having fixed information such as a design, the company's mark, etc. (col. 8, lines 46-48; col. 12, lines 37-57, referring to figure 15). Gradational images such as a photograph and handwritten signature are printed out by a sublimation transfer method and non-gradational images such as a name are printed out by a thermal transfer method to make best use of the properties of the two methods (col. 6, lines 48-55; figure 10). Hakamatsuka discloses that a flat transfer apparatus can be used where the cards are not flexible enough for a roll transfer apparatus (col. 11, lines 36-41). It is further disclosed (col. 13, lines 17-24):

The processing can be effected directly on a substrate, and no post-processing is needed. Since recording can be effected through editing process, it is possible to completely match each individual identification photograph, code information,

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e.g., name, post, ID number, etc., magnetic stripe recording information and emboss information.

The English abstract of Otsuka discloses manufacturing a plastic ID card from a sheet of synthetic resin using a plotter attached to a computer. A number of plastic cards are manufactured from one sheet of the synthetic paper. The translation discloses that the information is printed using an oil-based ink with a ballpoint pen, felt tip pen, etc. (translation, p. 8). The translation discloses (translation, pp. 8-9): "In the above example, multiple plastic cards were manufactured from one synthetic paper [4] which was mounted on the plotter [1], but it can be devised to manufacture one plastic card from one synthetic paper [4] mounted on the plotter [1]."

The Examiner's rejection finds (EA4) that Hakamatsuka does not disclose: (1) a plotting mechanism; (2) means for holding the pre-manufactured card in a printing position; (3) smudge resistant ink; and (4) means for delivering the ink. The Examiner states (EA4):

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the printer of Hakamatsuka et al. with the plotter of Otsuka since the Examiner takes Official Notice of the equivalence use in the art and the selection of any of these known equivalents to write information on a plastic card would be within the level of ordinary skill in the art. . . . Examiner takes Official Notice that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use

smudge resistant ink, means for delivering ink, and means for holding the plastic card on a plotting mechanism for printing information on a plastic card since it was known in the art that the use of smudge resistant [ink] is [sic, was] widely use[d] to prevent smudging when writing information on a substrate, means for delivering ink on a plotting mechanism is an essential part of a plotter [] to enable the delivery of ink to the printing area, means for holding the plastic card is a crucial component to prevent movement of the plastic card while information is being printed.

Appellants argue that Official Notice is only proper as to "facts," and that the Examiner misuses Official Notice. It is argued that it is not proper to take Official Notice of the motivation to combine or the equivalence of the printer in Hakamatsuka and the plotter of Otsuka (Br10-12) and that it is improper to use Official Notice for conclusions of law (Br12-13). It is further argued (Br14-15) that the Examiner relies on Official Notice as the "principal evidence" upon which the rejection is based, which is contrary to In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970).

"Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art." See Id. at 1091, 165 USPQ at 420; accord In re Pardo, 684 F.2d 912, 917, 214 USPQ 673, 677 (CCPA 1982). See also In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) (court will not take judicial notice of

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the state of the art). Official Notice is intended for facts which are common knowledge or capable of unquestionable demonstration. See In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961). See also In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

The rejection is not well stated. The language of the rejection clearly misuses the concept of Official Notice. Although "equivalents" under 35 U.S.C. § 112, sixth paragraph, is a factual determination, whether a printer and a plotter are "equivalents," even if they were in means-plus-function format (which they are not), is not proper for taking of Official Notice, especially where, as here, Appellants challenge the finding and provide arguments (Br11). The Examiner's statement that "Examiner takes Official Notice that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use smudge resistant ink, means for delivering ink, and means for holding the plastic card on a plotting mechanism for printing information on a plastic card since [these elements were known in the art]" (EA4) erroneously uses Official Notice in stating conclusions of law. However, the statements at the end of the sentence about what was known in the art are in the form of findings of Official Notice.

This is not to say that the combination of Hakamatsuka and Otsuka is without any merit. Hakamatsuka discloses printing on a pre-manufactured plastic card using a thermal transfer method to form non-gradational images, such as a name. Otsuka discloses printing directly on plastic using an oil-based ink with a plotter to make an ID card. The plastic has a "prepared writing surface" since the information can be written directly on its surface. The translation in Otsuka discloses that the plotter can be used to make one card at a time (translation, p. 9); thus, both Hakamatsuka and Otsuka disclose printing a single card. Since both Hakamatsuka and Otsuka are directed to making cards, one of ordinary skill in the art of creating customized cards would have considered it obvious to use the plotter of Otsuka to write on a pre-manufactured card, instead of the thermal transfer method in Hakamatsuka, because the plotter was a known alternative way to print a card. The Examiner's taking of Official Notice of "equivalents" was not required; the reasoning in the response (EA11-12) is much more persuasive.

The plotter in Otsuka (and, indeed, any conventional plotter) has a pen which constitutes a "means for delivering the ink." Thus, it was not necessary for the Examiner to take Official Notice of this fact. Also, it would have been within the knowledge of one of

ordinary skill in the art that there must be some structure for holding down the material to be printed on in a printing position in the plotter of Otsuka to keep the material from moving around. No means-plus-function interpretation has been advanced as to the "means for holding," so any structure satisfies this function. Thus, we generally agree with the Examiner's finding that "it was known in the art that . . . means for holding the plastic card is a crucial component to prevent movement of the plastic card while information is being printed" (EA4), although we would use the term "substrate" instead of the more specific "plastic card." Lastly, although we agree with the Examiner's finding that "it was known in the art that the use of smudge resistant [ink] is [sic, was] widely use[d] to prevent smudging when writing information on a substrate" (EA4), the reason why one of ordinary of ordinary skill in the art would have been motivated to use "smudge resistant ink" is because smudge resistance is a desirable property for ink on cards that will be handled frequently. Thus, properly argued, the Examiner did not really need to resort to Official Notice.

This analysis does not address all of the claim limitations. With respect to claim 1, the rejection does not address the limitations that "the customized pre-manufactured card have a unique

card identification affixed to each card" and "data entry means for entering the unique card identification." Similar limitations are found in method claim 41. All limitations in a claim must be addressed. See In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970) ("every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines"); In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). Accordingly, the rejection of claims 1, 41, and 42 is reversed. The APA does not cure the deficiencies with respect to claim 1; thus, the rejection of claim 2 is also reversed.

With respect to claim 23, the rejection does not address the limitations of a "host data processing system" and "means for sending and receiving both data and information from the host data processing system." The rejection of claim 23 is reversed.

Appellant argues that Hakamatsuka does not disclose issuance of pre-manufactured plastic cards during a single interview with the card issuing authority (Br9-10). We have trouble seeing how the single interview/card issuance limitations provide any structural or process limitations that distinguish over the references. Although

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the system in Hakamatsuka appears intended to be a central system, there is no structural or process reason why it cannot be used to issue cards during an interview, where the interview in Hakamatsuka is the time during which the personal information and photograph is gathered. Nor is there any structural or process reason why Otsuka cannot be used to issue cards during an interview. The fact that using the systems in Hakamatsuka or Otsuka would possibly be more complex and expensive than Appellant's system, and therefore not practical for a small card-issuing operation, is not a technical reason indicating nonobviousness. See Orthopedic Equipment Co., Inc. v. United States, 702 F.2d 1005, 1013, 217 USPQ 193, 200 (Fed. Cir. 1983) ("the fact that the two disclosed apparatus would not be combined by businessmen for economic reasons is not the same as saying that it could not be done because skilled persons in the art felt that there was some technological incompatibility that prevented their combination. Only the latter fact is telling on the issue of nonobviousness."); In re Farrenkopf, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983).

Claims 3 and 8 are similar to each other. The limitations of a "cardholder," "smudge resistant" ink, "means for delivering the ink," and card issuance during a client interview have been addressed

supra, As previously noted, since Otsuka prints directly on the plastic card, the card must have a "prepared writing surface," as broadly claimed. Claim 3 recites a "permanent water resistant ink" and claim 8 recites "permanent ink." The oil-based ink in Otsuka is considered to meet these limitations. In addition, however, it would have been within the level of skill of one of ordinary skill in the art to select the ink for its intended purpose and one of ordinary skill would have been motivated to use a permanent water resistant ink on a card that will be handled frequently so that the card is more durable and does not have to be replaced. A conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Claim 3 recites "means for entering a unique card number" and claim 8 recites "means for entry of card specific data." These limitations do not require that the card number or data be part of the card, as manufactured; compare claim 1, which recites "pre-manufactured plastic cards have a unique card identification affixed to each card." The unique card number and card specific data can refer to the ID number in Hakamatsuka and Otsuka which is printed on the card. For these

reasons, the rejections of claims 3 and 8 are sustained. Claims 6 and 7 are not separately argued and fall together with claim 3. Claims 12-15 and 19-22 are not separately argued and fall together with claim 8. Thus, the rejections of claims 6, 7, 12-15, and 19-22 are also sustained.

The plotter of claim 4 is taught by Otsuka, as discussed in connection with claim 1. The rejection of claim 4 is sustained.

Claim 5 recites a dot matrix printer. The Examiner takes Official Notice of the equivalence of a dot matrix printer to the printers in Hakamatsuka and Otsuka and concludes that it would have been obvious to replace the printer of Hakamatsuka with a dot matrix printer (EA6). The Examiner points to Appellant's statement that the printing system can take a variety of forms, such as a dot matrix, bubble jet printer, a laser printer, or a plotter (EA6). Appellant argues that there is nothing in the record which discloses a dot matrix printer for printing on a card during a client interview (Br20). In our opinion, one of ordinary skill in the art, having been taught in Hakamatsuka to use sublimation transfer and thermal transfer to print on a card and having been taught in Otsuka to use a plotter to print on a card, would have been motivated to use other conventional printing devices, such as a dot matrix printer, to print

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on a card. We do not rely on Appellant's statement that the printing device may take a variety of forms because it does not appear to be an admission as to prior art in the card printing art. The rejection of claim 5 is sustained.

With respect to claims 9-11, neither Hakamatsuka nor Otsuka disclose printing on a card having "pre-embossed alphanumeric characters." While we agree with the Examiner that embossing on cards is well known, this does not address the claimed invention of printing on a card that contains embossed characters. Thus, the Examiner has failed to make a prima facie case with respect to claims 9-11. The rejection of claims 9-11 is reversed.

Claim 16, 17, and 18 are directed to the prepared writing surface. As to claim 17, the Examiner finds that Hakamatsuka teaches a writing surface comprising paper at column 10, lines 37-38. Appellant argues that this disclosure relates to material used in sublimation printing, not paper to be used for a prepared writing surface (Br25). The paper base material 22a does not receive the actual printing and, so, is not a prepared writing surface. Thus, the rejection of claim 17 is reversed.

As to claims 16 and 18, the Examiner applies Cannistra, which the Examiner finds to disclose a writing surface comprising foil

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material and a matted finish at column 4, line 7, and column 3, lines 43+ (EA7). Appellant argues that Cannistra does not disclose printing on a prepared writing surface, but instead discloses a coating which is placed over the already printed information (Br22). We agree with Appellant that the coating and the magnetic foil strip in Cannistra are not part of a prepared writing surface. While we believe that at least a matted finish was known for such purposes as a signature strip, there is no teaching of using it for printing of information by a printer. The rejection of claims 16 and 18 is reversed.

Claim 47 describes the structure of the plotter, including an indentation to hold the card and a finger hole for assisting in removing the card from the cardholder. The Examiner takes Official Notice that it would have been obvious to design a finger hole to facilitate removal of the card (EA8, with respect to claim 24). Appellant argues that this is inappropriate for Official Notice (Br26). We agree with Appellant and find no other reasons that could be relied on. For at least this reason we conclude the Examiner has failed to establish a prima facie case of obviousness. The rejection of claim 47 is reversed.

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The limitations of claims 43-45 have been discussed in connection with claims 1, 3, 4, and 8. Because independent claim 43 does not contain the limitations of independent claim 1 on which the rejection was reversed, it does not stand or fall together with claim 1 as argued by Appellant (Br23). The separate patentability of claim 46 has not been argued. The rejection of claims 43-46 is sustained.

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CONCLUSION

The rejections of claims 1, 2, 9-11, 16-18, 23, 41, 42, and 47 are reversed.

The rejections of claims 3-8, 12-15, 19-22, and 43-46 are sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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